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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,995	02/02/2006	Jean-Jacques Zeiller	MERCK3129	2593
23599 7590 03/24/2010 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER				
ZUCKER, PAUL A				
ART UNIT		PAPER NUMBER		
1621				
NOTIFICATION DATE		DELIVERY MODE		
03/24/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

# Office Action Summary

**Application No.**

10/566,995

**Applicant(s)**

ZEILLER ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

1621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16 is/are rejected.
- 7) ☐ Claim(s) 8, 17 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/003)  
Paper No(s)/Mail Date 2/2/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Current Status***

1. This action is responsive to Applicants' amendment of 23 November 2009.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Applicant's cancellation of claims 14 and 15 is acknowledged.
4. Applicant's addition of new claims 16-18 is acknowledged.
5. Claims 1-13 and 16-18 are pending.
6. The rejection under 35 USC § 112, first paragraph, set forth in pages 3- 4 of the previous Office Action mailed 20 March 2009 is withdrawn in view of Applicants' amendment.
7. The rejections under 35 USC § 112, second paragraph, set forth in paragraphs 4 and 5 of the previous Office Action mailed 20 March 2009 are withdrawn in view of Applicants' amendment.
8. The rejections under 35 USC § 102 set forth in paragraphs 6 and 7 of the previous Office Action mailed 20 March 2009 are withdrawn in view of Applicants' amendment.
9. The Double Patenting rejection set forth in paragraph 8 of the previous Office Action mailed 20 March 2009 are withdrawn in view of Applicants' amendment.

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***New Rejections***  
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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-7 are finally ejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' specification does not provide support for the genus of compounds set forth in the proviso "the compounds where  $R^3$  = phenyl,  $R$  = ethyl,  $R^1$  = ethyl or phenyl and  $R^2$  = H" set forth in the 3<sup>rd</sup> line from the end of claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 16 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "wherein  $R^1$  is (C<sub>1</sub>C<sub>3</sub>) alkyl in line 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Bergmann et al (Journal of Organic Chemistry, Note on Preparation of Cyclohexen-1-aldehyde, 1958, 23, pages 1553-1554). Bergmann discloses (Page 1554, column 2, lines 19-40) the two compounds cyclohexenylmethoxyacetic acid and cyclohexenylpropoxyacetic acid which are compounds as claimed in instant claim 1. Bergmann therefore anticipates claim 1.
13. Claim 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Davies et al (Tetrahedron Letters, Regiochemistry of Molybdenum-catalyzed O-H Insertions of Vinylcarbenoids, 2000, 41, pages 4851-4854). Davies discloses (Page 4853, Table I, entry **6c**, reagent  $\text{RH}_2(\text{S-TBSP})_4$ ) the compound **6c** which corresponds to an instantly claimed compound of formula (I) in which  $\text{R}^1$  = methyl,  $\text{R}^2$ ,  $\text{R}^3$  =  $\text{C}_3$  alkylene in methanol solution. The Examiner considers this to correspond to a pharmaceutical composition. Davies therefore anticipates claim 1.
14. Claims 1-7 and 16 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Landais et al (Synlett, Electronic Versus Steric Effects in 5-*endo-trig*-like Electrophilic Cyclization, 1995, (11) pages 1191-1193). Landais discloses (Page 1191, column 2 top) the compound **3c** which corresponds to an instantly claimed compound of formula (I) in which  $\text{R}^1$ ,  $\text{R}^3$  = phenyl,  $\text{R}_2$  = H and R = ethyl. Landais discloses (Page 1191, Table 1, entry 3) a solution of this compound in phenol. The Examiner considers this to correspond to a pharmaceutical composition. Landais therefore anticipates claims 1-7 and 16.

***Claim Objections***

15. Claims 8, 17 and 18 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

16. Claims 1-13 and 16-18 are pending. Claims 1-7 and 16 are finally rejected. Claims 8, 17 and 18 are finally objected to. Claims 9-13 are held withdrawn from consideration as being drawn to a non-elected invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/  
Primary Examiner, Art Unit 1621